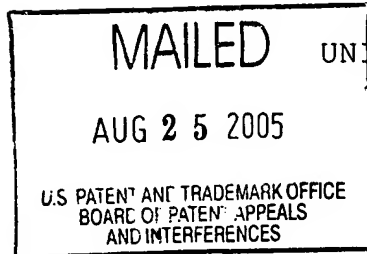


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM L. DETORE and TETSUYUKI KYONO

Appeal No. 2005-1863
Application No. 10/035,513

ON BRIEF

Before KIMLIN, McQUADE and BAHR, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 5-7. Claim 1 is illustrative:

1. A hybrid composite flywheel rim comprising: a cylindrical fiber-wound structure having at least two different types of fibers, including a first fiber type and a second fiber type, impregnated with a thermosetting resin such as epoxy resin and wound in an annulus on a mandrel, said two different fibers having different elastic moduli;

said fiber is distributed in said cylindrical fiber-wound structure as bands of tows, each tow having only a single type of fiber, said tows lying in a lay-up pattern that is defined by the correlation between lead rate per mandrel revolution and winding length to produce a random distribution of said first fiber type amongst said second fiber type macroscopically.

Appeal No. 2005-1863
Application No. 10/035,513

The examiner relies upon the following reference in the rejection of the appealed claims:

Kimura et al. (Kimura) 6,299,718 Oct. 9, 2001

Appellants' claimed invention is directed to a hybrid composite flywheel rim comprising two types of fiber impregnated with a thermosetting resin. The fibers include those of carbon and glass.

Appealed claims 1, 5 and 6 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 5 and 7 stand rejected under 35 U.S.C. § 102 as being anticipated by Kimura. Also, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the examiner's § 112 rejection is well-founded. However, we concur with appellants that the examiner has failed to make a prima facie case of anticipation or obviousness in support of the rejections under § 102 and § 103, respectively. Accordingly, we will sustain the examiner's § 112 rejection, but reverse the examiner's rejections under § 102 and § 103.

We consider first the examiner's rejection under § 112, second paragraph. We agree with the examiner that the claim

language "such as epoxy resin" to modify "a thermosetting resin" renders the claim indefinite. The examiner is on sound footing in explaining that one of ordinary skill in the art would be uncertain if the claims encompass only thermosetting resins which have properties like epoxy resin. We note that an amendment submitted by appellants "attempted to delete the 'such as epoxy resin' phrase from claims 1 and 5 that the Examiner considers to be objectionable" (page 2 of principal brief, penultimate paragraph).

Turning to the § 102 rejection of claims 1, 5 and 7, we agree with appellants that Kimura fails to describe within the meaning of § 102 a flywheel rim of any composition. Kimura only teaches a cylindrical part of fiber reinforced plastic composite material that can be used as a structural member. The examiner is unable to point to any disclosure in Kimura that describes a flywheel rim, and it is well settled that every feature of a claim must be described in a single reference to support a rejection under § 102. While the examiner states that "none of the limitations pertain to a flywheel" (page 7 of Answer, first paragraph), the language "flywheel rim" defines a structure that is amenable to functioning as a flywheel rim, which structure is not described in Kimura.


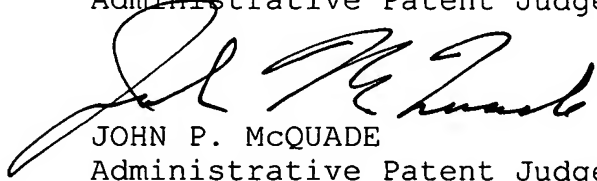

Appeal No. 2005-1863
Application No. 10/035,513

As for the § 103 rejection of claim 6, the examiner has not set forth any rationale why it would have been obvious for one of ordinary skill in the art to rely upon the Kimura disclosure to form a flywheel rim.

In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. §§ 102 and 103 are reversed, whereas the rejection under 35 U.S.C. § 112, second paragraph, is affirmed. Accordingly, the examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED-IN-PART

)	
EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	
)	BOARD OF PATENT
)	APPEALS AND
)	INTERFERENCES

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Appeal No. 2005-1863
Application No. 10/035,513

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